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**THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Serial No.: 10/664,737

Filed: September 18, 2003

Inventors: Chester L. Smitherman  
Leo J. Peters III  
Tuy Vu Mai

Title: Vehicle Based Data Collection and Processing System

Assignee: M7 Visual Intelligence, LP

Group Art Unit: 3661

Customer No.: 40184

Examiner: Unknown

Mail Stop Petitions  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

ATTN: Christina Tartera Donnell  
Senior Petitions Attorney

**CERTIFICATE OF EXPRESS MAILING**

Dear Sir:

I hereby certify that the following documents, which are attached, are being deposited under 37 CFR 1.10, with the United States Postal Service "Express Mail Post Office to Addressee" service as Express Mail No. EV 480191333 US in an envelope addressed to: Mail Stop Petitions, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

- (1) Request for Reconsideration of Petition Under 37 CFR § 1.47(a), with
  - a. Exhibit 1, *copy* of Decision Refusing Status Under 37 CFR § 1.47(a), mailed June 24, 2004;
  - b. Exhibit 2, *copy* of letter to Leo J. Peters III, dated June 30, 2004;
  - c. Exhibit 3, *copy* of certified mail return receipt postcard, dated July 10, 2004;

**BEST AVAILABLE COPY**

- d. Exhibit 4, *copy* of Declaration signed by inventors Smitherman and Tuy Mai on behalf of Leo J. Peters III; and
- e. Exhibit 5, *copy* of Response to Notice of Incomplete Reply, Petition Under 37 CFR 1.47(a), Petition Under 37 CFR 1.47(a)-Refusal to Sign, and Petition for Extension of Time, filed April 28, 2004, without Exhibits 1-4; and

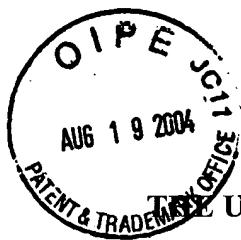
(2) Return Postcard.

Respectfully submitted,

8/19/04  
Date

  
\_\_\_\_\_  
Deborah K. Fooths, CLA  
Paralegal to Jennifer S. Sickler

HOUSTON 774628v1



THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 10/664,737

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Alexandria, VA 22313-1450

ATTN: Christina Tartera Donnell  
Senior Petitions Attorney

**REQUEST FOR RECONSIDERATION OF PETITION UNDER 37 CFR § 1.47(a)**

Dear Sir:

Assignee submits this Request for Reconsideration of Petition Under 37 CFR § 1.47(a) to the Decision Refusing Status Under 37 CFR § 1.47(a), mailed June 24, 2004. *See Exhibit 1*, a copy of the Decision.

**I. REQUEST**

The Petitions Attorney has requested proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers. *See Exhibit 1*. Assignee's attorney has attempted on several occasions to contact

inventor Leo J. Peters III regarding his execution of the Declaration for the above-referenced patent application, with the latest instance being a letter dated June 30, 2004, mailed to Mr. Peters by U.S. Express Mail, No. EV 169244447 US and Certified Mail Return Receipt Requested, No. 7160 3901 9848 4432 5202. *See Exhibit 2*, a true and correct copy of the cover letter dated June 30, 2004, detailing the contents of the mailing. The letter enclosed a copy of the patent application as filed with the U.S. Patent and Trademark Office, a Declaration for Mr. Peters execution, and a copy of the Assignment executed by Mr. Peters on September 26, 2002. Mr. Peters received the certified letter and the three (3) enclosures on July 10, 2004. *See Exhibit 3*, a true and correct copy of the certified mail return receipt postcard.

The Petitions Attorney also states that the applicant failed to submit an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64, and that the declaration does not identify the residence and mailing address of Mr. Peters. The Petitions Attorney has requested an oath or declaration in compliance with 37 CFR 1.63 and 1.67, which identifies the entire inventive entity, the correct mailing address and citizenship of each inventor, and is signed by the two signing inventors on behalf of Mr. Peters, the nonsigning inventor. Assignee hereby submits a Supplemental Declaration in compliance with 37 CFR 1.63 and 1.67. *See Exhibit 4*, a true and correct copy of the Declaration signed by inventors Smitherman and Mai, signing on behalf of inventor Leo J. Peters III, and showing that a petition has been filed. *See Exhibit 5*, a true and correct copy of the Response to Notice of Incomplete Reply, Petition Under 37 CFR 1.47(a)-Refusal to Sign, and Petition for Extension of Time, filed April 28, 2004, without Exhibits 1-4.

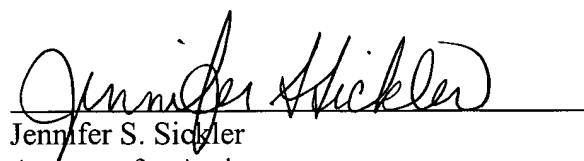
## II. REMARKS

Assignee has provided proof of several attempts to contact inventor Leo J. Peters III requesting his execution of the Declaration for said U.S. patent application. Assignee has also provided a properly executed Declaration in compliance with 37 CFR 1.63 and 1.67. Assignee contends that Mr. Peters should be deemed to have received adequate opportunity to execute the Declaration. His failure to return the executed Declaration and his oral communications with the undersigned, demonstrate his intention to refuse to participate in Application Serial No. 10/664,737. *See Exhibit 5*, Declaration of R. Bradford Perry. In light of the described situation, Assignee respectfully requests that the requirement for Mr. Peters to execute the § 1.63 oath or declaration be waived for Application Serial No. 10/664,737, pursuant to the Petition Under 37 CFR § 1.47(a), and the Request for Reconsideration be granted.

## III. CONCLUSION

Assignee respectfully submits that all required parts for the application have been filed and that the Petition and Extension of Time fees have been paid. *See Exhibit 5*. It is believed that no other fees are necessary. However, if this is incorrect, the Commissioner is hereby authorized to charge any underpayment, or credit any overpayment, to Deposit Account No. 07-0153 of Gardere Wynne Sewell LLP.

Dated: 8/19/04

  
\_\_\_\_\_  
Jennifer S. Sickler  
Attorney for Assignee  
Registration No.: 36,005  
Gardere Wynne Sewell LLP  
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Houston, Texas 77002-5007  
Phone: (713) 276-5382  
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JENNIFER S. SICKLER  
1000 LOUISIANA  
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HOUSTON TX 77002

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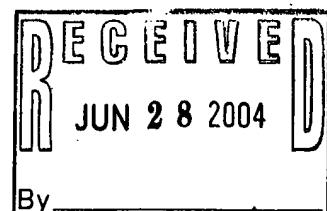
In re Application of :  
Smitherman et al. :  
Application No. 10/664,737 : DECISION REFUSING STATUS  
Filed: September 18, 2003 : UNDER 37 CFR 1.47(a)  
Attorney Docket No. 127976-1000 :  
: *RE: 10/664,737*

This is in response to the petition under 37 CFR 1.47(a), filed April 28, 2004. Applicants obtained a one-month extension of time to reply. Accordingly, the petition is filed timely.

The petition is dismissed.

Applicants are given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a). *Peters was present at the filing of this application*

The above-identified application was filed on September 18, 2003, with a declaration without all of the inventors' signatures. Accordingly, on January 29, 2004, the Office mailed a "Notice to File Missing Parts of Nonprovisional Application," requiring the signatures of Tuy Vu Mai and Leo Peters III and a surcharge for the late filing of the declaration. Additionally, the Notice to File Missing Parts indicated that a new oath or declaration was required, which identified the residence of each inventor.



On January 29, 2004, the Office also mailed a Notice of Incomplete Reply, stating that the reply on October 20, 2003, to the Notice to File Missing Parts had been entered. However, the reply did not include the signature of Leo Peters III. Again, the Office indicated that a new oath or declaration was required, which identified the residence of each inventor.

In response, on April 28, 2004, applicants filed the present petition, a declaration signed by two of the three joint inventors, a request for a one-month extension of time to reply, and paid the necessary fees.

In the Declaration of Facts, R. Bradford Perry states that the assignee, through its attorney, sent Leo J. Peters III a letter dated September 26, 2003, enclosing a Declaration for execution. A copy of the letter accompanies the petition. The letter indicates: "Enclosed for your review and execution is a Declaration and Power of Attorney for the nonprovisional patent application." Letter of Jennifer S. Sickler, dated September 26, 2003. Mr. Perry further states that Mr. Peters indicated that he was not willing to sign declaration, and has failed to do so.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicants lack items (1) and (2) as set forth above.

As to item (1), it appears that Mr. Peters was presented with only a copy of the Declaration and Power of Attorney. Unless Mr. Peters was presented with a complete copy of the application papers, including the specification, claims and drawings, he could not attest that he has "reviewed and understands the application papers," and therefore, could not sign the declaration that he was given. Accordingly, applicants failed to show or provide proof that the nonsigning inventor has refused to sign the declaration. See MPEP 409.03(d). To show that the inventor has refused to join in the application, applicants must show that complete copies of the application papers, including the specification, claims and drawings, were presented to Mr. Peters, personally or through his designated representative, and that he did not respond to the request that he sign the declaration.

As to item (2), applicants failed to submit an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64. The declaration does not identify the residence or mailing address of Mr. Peters. The Office notes that the oath or declaration must identify "[t]he mailing address, and the residence if an inventor lives at a location which is different from where the inventor customarily receives mail, of each inventor. . . ." 37 CFR 1.63(c)(1). Accordingly, to correct the deficiencies, applicants must submit an oath or declaration in compliance with 37 CFR 1.63 and 1.67, which identifies the entire inventive entity, the correct mailing address and citizenship of each inventor, and is signed by the two signing inventors on behalf of Mr. Peters, the nonsigning inventor.

Further correspondence with respect to this matter should be addressed as follows and **to the attention of Christina Tartera Donnell, Senior Petitions Attorney:**

By mail: Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

By FAX: (703) 872-9306  
Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office  
220 20<sup>th</sup> Street S.  
Customer Window, Mail Stop Petition  
Crystal Plaza Two, Lobby, Room 1B03  
Arlington, VA 22202

Telephone inquiries concerning this matter may be directed to the undersigned at (703) 306-5589.

*Christina Tartera Donnell*

Christina Tartera Donnell  
Senior Petitions Attorney  
Office of Petitions

GARDERE

attorneys and counselors ■ [www.gardere.com](http://www.gardere.com)

Direct: 713-276-5382  
Direct Fax: 713-276-6382  
[jsickler@gardere.com](mailto:jsickler@gardere.com)

June 30, 2004

Certified Article Number

7160 3901 9848 4432 5202

SENDERS RECORD

Via U.S. Express Mail - EV 169244447 US  
and Certified Mail RRR - 7160 3901 9848 4432 5202

Mr. Leo J. Peters III  
129 Phanturn  
Bellaire, Texas 77401

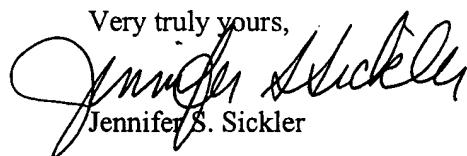
Re: Utility Patent Application for "Vehicle Based Data Collection and Processing System"  
Filing Date: September 18, 2003

Dear Leo:

This correspondence is to follow-up to our telephone conversation on October 10, 2003, during which we discussed your execution of the Declaration for the above-referenced patent application, which was filed on September 18, 2003. Enclosed is a copy of the patent application as filed with the U.S. Patent and Trademark Office and another Declaration for your execution. Please be reminded that due to your prior assignment of the invention to Visual Intelligence, you have a legal obligation to sign documents to aid the Assignee Visual Intelligence in obtaining and enforcing protection for the invention. Enclosed is a copy of the executed Assignment for your reference.

Please return the original signed Declaration to me by July 14, 2004 for filing with the USPTO. Enclosed is a stamped self-address return envelope for your use. I look forward to hearing from you. Your failure to return the signed document, or to otherwise communicate with me about this by July 14<sup>th</sup>, shall be taken as a continuing refusal to sign the document.

Very truly yours,

  
Jennifer S. Sickler

JSS:dkf  
Enclosures

- (1) Copy of Patent Application
- (2) Declaration
- (3) Copy of Assignment

GARDERE WYNNE SEVELL LLP

1000 Louisiana, Suite 3400, Houston, Texas 77002-5007 ■ 713.276.5500 Phone ■ 713.276.5555 Fax  
Austin ■ Dallas ■ Houston ■ Mexico City ■ Washington, DC

Mr. Leo Peters III

June 30, 2004

Page 2

bcc: Brad Perry (*M7 Visual Intelligence, LP*)  
(*Brad, PTO required us to try again and to attach the patent application*)

HOUSTON 766736v1

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<b>2. Article Number</b>  <b>7160 3901 9848 4432 5202</b>		<b>COMPLETE THIS SECTION ON DELIVERY</b>	
<b>A. Received by (Please Print Clearly)</b> <b>Leo J. Peters III</b>		<b>B. Date of Delivery</b> <b>7/10/04</b>	
<b>C. Signature</b> 		<input type="checkbox"/> Agent <input checked="" type="checkbox"/> Addressee	
<b>D. Is delivery address different from item 1?</b> If YES, enter delivery address below:		<input type="checkbox"/> Yes <input type="checkbox"/> No	
<b>Reference Information</b>			
127976-1000 Jennifer S. Sickler			
<b>PS Form 3811, July 2001</b>		<b>Domestic Return Receipt</b>	